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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/594,221

09/25/2006

Takashi Sueyoshi

8007-1116

1846

466 7590 11/07/2008
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EXAMINER

OJURONGBE, OLATUNDE S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

11/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|--|--|
| Office Action Summary | Application No. 10/594,221 | Applicant(s) SUEYOSHI ET AL. | |
| | Examiner OLATUNDE S. OJURONGBE | Art Unit 1796 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment filed 29 July, 2008 has been entered. Claims 1-5 remain pending in the application.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

3. **Claims 1 and 3-4** are rejected under 35 U.S.C. 102(b) as being anticipated by **Koichiro et al (JP 2002-173661)**.

The rejection of claims 1 and 3-4 remain the same as set forth in the office action dated 29 April 2008.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

5. **Claims 2 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Koichiro et al (JP 2002-173661)** in view of **Verbruggen et al (WO 03/066707)**.

The rejection of claims 2 and 5 remain the same as set forth in the office action dated 29 April 2008.

Response to Arguments

6. Applicant's arguments filed 29 July, 2008 have been fully considered but they are not persuasive.

The applicant argues *The position of the Official Action appears to be that the components (A) and (B) of the claimed invention are identical/similar to the compound of KOICHIRO based on the following misunderstandings i) to iii) :*

(i) the total (molecular weight) of a reactive group A' contained in the component (A) is 1000 or less; the ratio of the reactive group A' to the component (A) is 20% by weight or less.

(ii) The total (molecular weight) of an Si-H group contained in the component (B) is 1000 or less; the ratio of the Si-H group to the component (B) is 20% by weight or less.

(iii) The recitation of ~having an Si-O-Si bridge structure" of the claimed invention is misinterpreted to simply --have an Si-O-Si bond--.

As to the above misunderstanding (i), the claimed invention recites "the amount of a component whose molecular weight is 1000 or less contained in the component (A) is 20% by weight or less based on the component (A)" The claimed invention does not specify the content ratio of the reactive group A' in the component (A).

The examiner disagrees. In regards to the purported misunderstanding (i), the claim limitation is broad enough to be met by the combination of the two $\text{H}_2\text{C}=\text{CH}$ – groups of the organopolysiloxane of Formula 3 of Koichiro. The combination of the two $\text{H}_2\text{C}=\text{CH}$ - groups is a component of the organopolysiloxane of Formula 3 of Koichiro, whose molecular weight is less than 1000 and is 20% by weight or less.

Formula 3 of Koichiro serves as the component (A) of the instant claim.

The amended claim 1 is still broad enough to be met by Koichiro as explained in prior office action, as the two $\text{H}_2\text{C}=\text{CH}$ - groups of the organopolysiloxane of Formula 3 of

Koichiro are a kind of a reactive group that is a component of the organopolysiloxane of Formula 3 of Koichiro, and the two $\text{H}_2\text{C}=\text{CH}-$ groups is less than 20% by weight, with weight average molecular weight less than 1000.

Formula 3 of Koichiro serves as the component (A) of the instant claim. The claim does not specify that the component whose weight average molecular weight is less than 1000 has to be different from the reactive group A' of component (A).

Furthermore, the structure of the organopolysiloxane of Formula 3 of Koichiro depicts Si-O-Si.

Similar explanation applies to the purported misunderstanding (ii), with Formula 7 replacing Formula 3, and the two terminal hydrogendimethylsiloxy groups of Formula 7 replacing the two $\text{H}_2\text{C}=\text{CH}-$ groups of Formula 3 of Koichiro.

The applicant further argues *As to the above misunderstanding iii), the compound of KOICHIRO (e.g., the compound represented by formula (4) that is pointed out in the Official Action) indeed has an Si-O-Si bond in its main chain, but the compound merely has a simple straight line structure, which is totally different from the Si-O-Si bridge structure as claimed.*

The examiner disagrees. Firstly, the compound represented by formula (4) was not pointed out in the prior office action; furthermore, according to Oxford University Press dictionary, "a bridge is a thing that provides connection or contact between two different thing", since the Si-O-Si bond of the compound of Formula 3 of Koichiro provides connection between the two $\text{H}_2\text{C}=\text{CH}-$ groups of the compound, then the Si-O-Si structure of Koichiro is a bridge structure.

Same reasoning applies to the compound of Formula 7, with the Si-O-Si structure connecting the two terminal hydrogendimethylsiloxy groups of the compound.

The applicant further argues *The silicon containing composition of the claimed invention stands in contrast to KOICHIRO. As can be taken from the description at [0018] of the present specification that "the component (A) may have a ladder configuration, a cage configuration, a cyclic configuration, etc., depending on the bridge configuration", the bridge structure of the present invention is a particular structure which can form a ladder configuration, a cage configuration, and a cyclic configuration. These configurations can be formed by linking one atom or atomic group in a molecule having a straight line structure such as KOICHIRO's one to another atom or atomic group in the same molecule or by linking two or more molecules having a straight line structure together.* This argument is based on limitations that are not present in any of the instant claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Hence, the neither the list of amendments nor the applicant's remarks present the application in the condition for allowance.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1796

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLATUNDE S. OJURONGBE whose telephone number is (571)270-3876. The examiner can normally be reached on Monday-Thursday, 7.15am-4.45pm, EST time, Alt Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571)272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

O.S.O.

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796